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In re Application of
HICKS, Debra L. *et al*
U.S. Application No.: 09/230,275
PCT No.: PCT/US97/13321
Int. Filing Date: 23 July 1997
Priority Date: 24 July 1996
Attorney Docket No.: 5093
For: CHOLESTEROL SEPARATION AND
FLUORESCENT ANALYSIS

DECISION ON
PETITION TO WITHDRAW
NOTICE OF ABANDONMENT

This decision is in response to the "Petition to Withdraw Notification of Abandonment" filed via facsimile on 30 March 2000, requesting the United States Patent and Trademark Office ("Office") withdraw the holding of abandonment for the above captioned application. This is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 07 July 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) was required. A one month time limit in which to respond was set.

On 02 March 2000, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed stating that the above captioned application was abandoned due to applicants' failure to timely respond to the Notification of Missing Requirements.

On 07 December 1998, applicants submitted the instant petition via facsimile which was accompanied by a copy of a "Notice of Change of Correspondence Address."

DISCUSSION

Counsel claims that the Notification of Missing Requirements mailed 07 July 1999 was never received. The showing required to establish the failure to receive an Office communication (set forth in section 711.03(c) of the Manual of Patent Examining Procedure (MPEP), page 700-92 and 1156 O.G. 53, November 16, 1993) must consist of (1) a statement from the practitioner declaring that the Office communication was not received by the practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and, (3) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Regarding item (1), applicants' attorney attests that "[t]here was no notification of Missing Requirements in the physical file" and later that there was also "no notification of Missing Requirements in the corresponding PCT application file." Pet. ¶ 3. These statements satisfy item (1).

With regards to item (2), applicants' attorney states that "I have personally reviewed the complete physical file for this U.S. application," and "I also personally reviewed the physical file for the corresponding PCT application." *Ibid.* Counsel then declares that "I have personally reviewed all the computerized docket sheets for this U.S. application," and "I also personally reviewed all the computerized docket sheet for the corresponding PCT application." *Id.* at ¶ 4. These statements satisfy item (2).

However, item (3) requires counsel to provide a copy of the docket record(s) where the nonreceived Office communication would have been entered had it been received and docketed. This has not been provided. Thus, item (3) is not satisfied.

Accordingly, applicants have not yet met the requirements required to establish nonreceipt of an Office action.

CONCLUSION

In view of the above, the petition is DISMISSED without prejudice.

Accordingly, the above-captioned application remains ABANDONED.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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